

## **REMARKS**

Claims 1-14, 16-18, and 20-22 are pending. Claims 15 and 19 have been canceled.

Claims 21-22 have been added. Claim 21 finds support in and corresponds to claim 1. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

### **Status of the Application**

1. The drawings were objected to.
2. The Specification was objected to. The Specification at page 39 has been amended with regard to the Figures 31-38 description in the manner suggested by the Office. Applicants respectfully decline the Office's invitation to limit their Specification page 44 description of elements 294 and 296. Thus, Applicants respectfully traverse the page 44 objection.
3. Claims 2, 7, and 20 were objected to. Applicants respectfully traverse the objections. The language "the opposite end" has clear antecedent basis support.
4. Claims 1-20 were rejected under 35 U.S.C. § 112, second paragraph. Applicants respectfully traverse the rejections. The claim language is clear that a picker roller can pick a sheet, and that the picker shaft has at least one picker roller thereon. Additionally, one skilled in the art understands the relationships among a picker shaft, a picker roller, and picking a sheet. Furthermore, the claim 1 language (at lines 12+) is clear that the picker shaft has either a male or female mating portion, and the drive shaft has the other (remaining) one of the male or female mating portion. The female mating portion can receive the male mating portion.
5. Claims 1-4 and 9-15 were rejected as obvious under 35 U.S.C. § 103(a) over Donnis (US 6,296,245) in view of Hiroshi (JP 10-025033).

6. Claims 5-8 were rejected as obvious under 35 U.S.C. § 103(a) over Donnis in view of Toda (US 2003/6546).

7. Claims 16-18 were rejected as obvious under 35 U.S.C. § 103(a) over Donnis in view of Tanaka (US 5,863,036).

8. Claim 20 was rejected as obvious under 35 U.S.C. § 103(a) over Donnis in view of Hiroshi, Toda, and Tanaka.

#### **The Donnis in view of Hiroshi Rejections**

The Office has not established a *prima facie* case of obviousness. Donnis and Hiroshi are both non analogous art to the recited invention. Donnis is directed to feeding paper sheets from a ream into an ink jet *printer* (e.g., col. 1, lines 8 and 30). Hiroshi is likewise directed to feeding paper sheets into a copy machine or a *printer* (e.g., paragraph [0002]). How are these references analogous to the environment of an "automated banking machine currency dispenser" and being "configured to pick currency notes from a currency cassette"?

The Office has not shown that the printer (or copier) of Donnis or Hiroshi can dispense currency notes, especially when currency notes (cash) have a different size and texture from printer (or copier) paper. Nor has the Office shown that the printer (or copier) of Donnis or Hiroshi can be used with an "automated banking machine currency dispenser", especially to pick currency notes from a "currency cassette". Also, a currency cassette typically has security features that a non secure (open) paper tray does not have. The Office has not shown any evidence that a printer (or copier) can use a currency cassette. Nor has the Office shown that a currency cassette can be used to dispense (typically larger) printer or copier paper. It would not have been obvious to one having ordinary skill in the art to have even attempted using the non

analogous teachings of Donnis and Hiroshi to have produced the recited invention.

Additionally, Donnis does not teach an automated banking machine media dispenser at col. 1, lines 6-11, as alleged by the Office. Nor does Donnis teach the alleged currency cassette. The item (13) in Donnis is a paper tray for a printer. Nor is the cylindrical seat (110) a drive pin. Again, the Office has not established a *prima facie* case of obviousness.

Even if (for sake of argument) it were somehow possible (which it isn't) for the references to have been combined as alleged, the result still would not have produced the recited invention. The combined references would still lack all of the recited features and relationships.

Nor has the Office explained how Donnis could be modified to have produced the recited invention, especially without destroying the disclosed utility and operability of Donnis' clutch arrangement. An obviousness rejection cannot be based on a combination of features that would result in destroying the utility or advantage of the device taught in Donnis, which is the current situation. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1598-99 (Fed. Cir. 1988).

The attempts to modify Donnis are clearly attempts at hindsight reconstruction of Applicants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). The rejections, which lack the necessary evidence and rationale, are based on knowledge gleaned only from Applicants' disclosure.

### **The Other Rejections**

Applicants respectfully submit that the other relied upon references cannot alleviate the many deficiencies noted above in Donnis and Hiroshi. For example, Toda is not directed to a picker shaft and drive shaft relationship. Nor is Toda directed to an arrangement that can pick notes from a currency tray, but rather a paper tray itself. In Toda's paper tray the relied upon

flexible portion (37) of the operation tab (35) has a shaft (36) integral therewith (Figure 8). The shaft (36) is not in rotatably supported engagement with the portion (37). As best understood, the portion (37) is flexible in order to facilitate the placement of its shaft (36) into a hole (33) in the sidewall (31) of the tray's side guide (30). Note Toda at column 2 of page 3.

#### Claims 5-8

Original claims 5-8 depended on claim 4/3/2/1. The Action admitted deficiencies in Donnis, and therefore relied on Hiroshi in rejecting original claim 4. Yet, the rejection of original claims 5-8 did not rely on Hiroshi. It follows that the Office itself admits that a *prima facie* case of obviousness was not established.

#### Claim 9

Likewise, claim 9 depends from claim 7. The claim 7 rejection relied upon Toda. Yet, the claim 9 rejection is absent Toda. Again, the Office admittedly has not established a *prima facie* case of obviousness.

#### Claims 16-18

Claims 16-18 depend from claim 10/1. The claim 10 rejection relied upon Hiroshi. Yet, the rejection of claims 16-18 is absent Hiroshi. Again, the Office admittedly has not established a *prima facie* case of obviousness.

#### **Clarification is Requested**

The record is not exact as to whether original claim 19 stands withdrawn or rejected. Original claim 19 was rejected under 35 U.S.C. § 112, second paragraph. Thus, the record points to the indication that method claim 19 was indeed examined on the merits.

### The Drawing Objections

Applicants respectfully traverse the drawing objections. The drawings were objected to under 37 CFR 1.83(a). The Office indicates (at Action page 3) that a "structural detail" showing is needed for an "understanding of the *disclosed* invention". However, 37 CFR 1.83(a) only requires that the drawings "show every feature of the invention specified in the *claims*". That is, drawings only need to show the *claimed* invention, not the *disclosed* invention. The Examiner does not cite where the indicated "structural detail" appears in any of the *claims*. Thus, a showing thereof is not required.

Furthermore, it is unclear how the alleged need for a "*structural* detail" showing relates to the recited method. It is USPTO policy that when an application includes at least one process claim, then a drawing is *not* necessary for an understanding of the invention, nor is any drawing even required. That is, a recitation of a method claim cancels the need for drawings. Note MPEP § 601.01(f) and MPEP § 608.02(III). This application includes at least one method claim. Thus, the drawing objection is *prima facie* contrary to USPTO examination policy.

Applicants respectfully request the Office to withdraw the drawing objections. Applicants reserve the right to delete all of the (not required) drawing figures and references thereto to remove any possibility of drawing objection.

Nevertheless, as a courtesy to the Office, Figure 30 has been amended as requested by the Office. Specifically, the spring member 298 and the spring member 299 have been moved closer to respective shafts 290 and 292. A "Request to Amend Drawings" is attached herewith.

As discussed in the Specification (e.g., page 44, lines 14-21), the fastener members 294, 296 can comprise a spring clip. The fastener members 294, 296 can be spring biased to produce a clamping force. The clamping force can be set at a force level such that it can be manually

overcome. For example, a fastener member 294, 296 can have a tapered entrance with two flanges forming an opening. The opening can be of a diameter smaller than the diameter of a pivoting shaft 290, 292. Moving a shaft through the entrance can cause the opening to expand. After a shaft 290, 292 passes through the entrance, the opening can retract to its unbiased (normal) state, thus retaining (or locking) a shaft inserted in the fastener member 294, 296.

Furthermore, a fastener member 294 enables play in a retained pivot shaft 290 (e.g., page 45, line 12). Resilient spring member 298 produces a force (e.g., a push that reduces the play) against the pivot shaft 290 to bias the pivot shaft 290 toward the picker shaft 230. For shaft 290 removal from fastener member 294, the resilient spring member 298 force can be removed, and the shaft 290 manually moved out of the fastener member 294 in a direction away from the picker shaft 230 (e.g., page 43, line 20+). A manner of attaching the fastener members 294, 296 to the dispenser module 229 is within the skill level of one having ordinary skill in the art.

Applicants respectfully submit that Figures 35-38 are sufficiently described in the disclosure, especially in view of the replacement paragraph at Specification page 39.

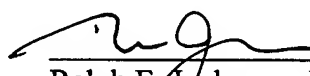
Applicants respectfully request that the drawing objections be withdrawn.

### **Conclusion**

Applicants respectfully submit that this application is in condition for allowance.

The undersigned is willing to discuss any aspect of the Application by phone.

Respectfully submitted,

  
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